## Remarks

Claims 2 and 21 have been amended herein. New claims 35-47 have been added. Claims 1-47 are now pending in the application.

## The Drawings Submitted With the Application Satisfy the Statutory Requirements

In the Action the drawings were objected to because items 12, 14, 20, 22, 24 and 26 in Figure 1 were asserted to lack a description, and because items 32, 52, 54, 56, 58, 60, 62, 109 and 110 in Figure 2 were asserted to lack a description. This rejection is respectfully traversed.

Each of these elements is described in the Specification. For example, home bank computer system (14) and servers (20, 22, 24, 26 and 28) are discussed in the Specification at page 9, lines 4-10. Interface (32) is described on page 9, lines 19-20. Interfaces (52, 54, 56, 58, 60 and 62) are described in the Specification at page 10, lines 7-9. It is therefore respectfully submitted that each of these items is fully "described" in the Application.

Applicants also wish to respectfully point out that there are no reference numerals (109 and 110) in the pending drawings. The Request to Amend Drawings filed March 10, 1999 and which was approved and entered as indicated in the recent Office Action, eliminated these reference numerals from Figure 2.

No additional descriptive material is required in the pending drawings because the Specification makes clear the nature of each component. The provisions of 37 C.F.R. § 1.84(o) indicates that the use of descriptive legends in drawings is not mandatory and such legends should only be included where necessary for understanding the invention. Applicants respectfully submit that no additional descriptive legends are necessary in this case to understand the nature of the inventions described in connection with Figure 1 and Figure 2.

In order to obviate any possible objection Applicants are submitting herewith a Request to Amend Drawings and a marked informal drawing adding descriptive legends to elements (12, 14, 20, 22, 24, 26 and 28) in Figure 1, as well as elements (32, 52, 54, 56, 58, 60 and 62) in Figure 2. No new matter is added as a consequence of adding these descriptive legends as the legends correspond to the description of each element in the Specification. Formal drawings implementing the changes to Figures 1 and 2 are also enclosed.

It is respectfully submitted that this amendment obviates any possible objection to the drawings.

### This Specification Meets all Statutory Requirements

In the Action the Specification was objected to due to an alleged failure to include an Abstract. This rejection is respectfully traversed.

This Application is the national phase of International Application No. PCT/US97/21422. This Application as filed included an Abstract. This is reflected in the PCT Application transmittal, the published International Application, and the Notice issued by the U.S. Patent Office dated January 12, 1999 indicating that the Application was entered into the U.S. national phase and that all requirements under 35 U.S.C. § 371 had been met. As the U.S. Patent Office has acknowledged numerous times that this Application was filed with an Abstract, it is respectfully submitted that the objection presented in the Action is improper and should be withdrawn.

Applicants have attached hereto a copy of the Abstract filed with the original Application. It is respectfully submitted that this obviates any possible objection.

The Action also included a reminder that when trademarks are used in a patent

application such marks must be respected and suitable generic terminology included. It is respectfully submitted that Applicants have met these requirements. No instances where Applicants failed to meet these requirements were pointed out in the Action. Therefore it is respectfully submitted that there is no basis for any objection to the Specification.

## Allowable Subject Matter

In the Action claims 2-3 and 21-24 were acknowledged as reciting allowable subject matter. Claims 2 and 21 have been amended herein to be independent claims by incorporation of material features of the claims from which they originally depended. It is respectfully submitted that claims 2-3 and 21-24 are now in condition for allowance.

## Applicants' Claims Are Not Anticipated by the Cited Art

In the Action claims 1, 6, 10-14 and 31-34 were rejected pursuant to 35 §102(e) as anticipated by Bernstein, et al. ("Bernstein"). This rejection is respectfully traversed.

As later discussed, Bernstein does not constitute prior art against Applicants' invention. The present Application claims priority of U.S. Provisional Application 60/031,956 filed November 27, 1996. Applicants reduced their invention to practice in this country prior to Bernstein's July 27, 1996 filing date. Although Bernstein is not prior art, Applicants also respectfully assert that the disclosure of Bernstein does not anticipate or render obvious Applicants' claimed invention.

The Action asserts that Bernstein teaches that an automated teller machine is a kiosk. The Action further asserts that it is well known in the art for an ATM to include an output device such as a display, an input device such as a keypad or card reader, and a sheet dispenser

14

mechanism. The Action further asserts that Bernstein teaches that a kiosk comprises a microprocessor, memory and storage devices. The Action further asserts that Bernstein teaches printing operations. The Action further asserts that Bernstein teaches the computer operating a web browser and that it is inherent that a web browser sends, receives and translates HTML documents.

The Action further asserts that Bernstein teaches a "print button" on the browser and that depending upon the button image touched, the browser is instructed by the GUI controlled software to perform the corresponding function (Col. 5, lines 42-45).

The Action further asserts that one of ordinary skill would realize that a sheet dispenser or printer mechanism could be connected with the claimed device application since Bernstein teaches that a kiosk may be an ATM (Col. 1, lines 10-14) and that a sheet dispenser would be part of an ATM. The Action further asserts that Bernstein teaches that depending on the button image touched, the browser is instructed by the GUI control to perform the corresponding function, and if a user presses the print button the kiosk will print and dispense the sheet.

The Action further mentions claims 31-34 but does not indicate how the Bernstein reference is asserted to be pertinent to such claims (See Action page 4, lines 5-6). Specifically the statement in the Action that "with respect to claims 31-34, the limitations of claims 31-34 are discussed in the rejection of claims and, therefore, will not be repeated" does not indicate any basis for rejection of these claims.

To the extent that the rejections are understood, Applicants respectfully take exception thereto.

15

## The Bernstein Reference

Bernstein discloses a kiosk system. Bernstein's kiosk includes a housing or casing (21). The casing houses a microprocessor (30), a keyboard (22), a mouse (24), a memory (32), and a display screen (27) (Col. 3, line 66-col. 4, line 15). The keyboard and the mouse are normally locked in the casing and not accessible to anyone other than authorized personnel of the owner of the kiosk (Col. 4, lines 29-33). Bernstein discusses that his kiosk may alternatively be a desktop computer where the mouse and keypad are accessible to all users (Col. 4, lines 3-5). In such desk top installations Bernstein installs security software in the computer to prevent users from using the computer in unwanted ways (Col. 4, lines 33-37).

In Bernstein's kiosk the microprocessor (30) runs browser software (Col. 4, line 14). In the Bernstein system a Netscape™ browser is used which operates to produce menu and status bars on the screen. Bernstein's asserted innovation is that the menu and status bars of the standard Netscape™ browser output are hidden from the user to avoid tampering (Col. 4, lines 54-57).

Bernstein uses proprietary GUI control software that generates a first image (40) to mask the menu bar and title area of the Netscape™ browser output. Bernstein's software also generates an image (42) that masks the horizontal scroll bar, and generates a third image (44) that masks the vertical scroll bar (Col. 4, lines 57-64, Figure 4). The masking images are generated as bit map images that are input to the operating system of the microprocessor (30) to overlie the unwanted portions of the browser interface (Col. 4, line 65-Col. 5, line 7). The overlying masking images are created by proprietary GUI control software owned by Bernstein's company (Col. 5, lines 4-7). The overlying images prevent a user from accessing the functions of the browser which would normally be accessed by clicking on icons underlying the masking images

16

(Col. 5, lines 20-22).

Bernstein includes certain button images in the masking images that are generated to overlie the browser control icons. Button images are included in the top image (40) overlying the menu bar of the browser output, and in the bottom image (42) overlying the status and horizontal scroll bar of the browser output. These button images include a "go back" button (46), a "print" button (47), a "scroll up" button (49), a "scroll down" button (50), a "scroll left" button (52) and a "scroll right" button (54) (Col. 5, lines 22-29).

The buttons that Bernstein includes in his overlying images can only correspond to the underlying browser functions (Col. 5, lines 34-37). Bernstein's kiosk includes a touch screen. An enhanced mouse driver program Bernstein has developed detects when a user "touches" one of the "buttons" (46, 47, 49, 50, 52, 54) on the touch screen. Touching one of the buttons causes Bernstein's proprietary GUI control software to instruct the browser software to perform the corresponding function (Col. 5, lines 37-49).

Bernstein's proprietary software allows the owner of the kiosk to set up the appearance of the windows that overlie the normal browser control icons. The owner is also enabled to provide "buttons" in the overlying images for only those functions that can be carried out by clicking on the menu bar of the Netscape™ software (Col. 5, line 61 - Col. 6, line 9).

Bernstein's proprietary GUI control software may also include a security module. The security module may be used to limit access to certain URLs (Col. 6, lines 24-25; Col. 6, lines 46-47). This enables the owner of the kiosk to prevent a user from accessing web pages that the owner of the kiosk does not want the user to access. In situations where Bernstein system is run as a desktop unit where users have access to the keyboard and mouse, the security control software may also be used to limit the system functions that a user may perform (Col. 6,

17

lines 25-31).

## Brief Description of Invention

An exemplary embodiment of Applicants' invention claimed in the present Application is automated banking machine system. The system includes a banking machine that includes a computer which operates a browser or other HTML document handling software therein. The banking machine also includes a sheet dispenser mechanism such as a note dispenser.

The banking machine operates to receive HTML documents. The documents include instructions that are processed by the HTML document handling software. The banking machine operates in response to instructions included in the documents that are received, to control the sheet dispenser to dispense sheets such as currency notes.

It is respectfully submitted that nothing in the cited art discloses or suggests these features.

## The Legal Standard

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in such a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768, (Fed. Cir. 1987).

It is respectfully submitted that Applicants' claims are not anticipated by the cited art.

## Applicants' Claims Patentably Distinguish Over the Bernstein Reference

### Claim 1

Claim 1 recites a banking machine that includes an output device, an input device, and a sheet dispenser mechanism. Claim 1 further recites a computer operatively connected with the output device, the input device and the sheet dispenser mechanism. Claim 1 further recites software in the computer including an HTML document handling portion which is operative to receive HTML format documents. Claim 1 further recites that the software operating in the computer includes a device application portion that interfaces with the HTML document handling portion. It is further recited that the device application portion is in operative connection with the sheet dispenser. Claim 1 further recites that the device application portion operates to cause the sheet dispenser to dispense at least one sheet in response to the HTML document handling portion receiving an HTML document including a dispense instruction.

Applicants respectfully submit that Bernstein neither discloses or suggests numerous features that is specifically recited in claim 1.

Claim 1 specifically recites a sheet dispenser mechanism. Bernstein's kiosk is specifically described as including a monitor (25), computer (30), a memory (32), a keyboard (22), a mouse (24) and a modem or network adaptor (31). There is absolutely no sheet dispenser mechanism such as a currency dispenser, included in the kiosk of Bernstein.

The Action points out that Bernstein does discuss including the use of a "print" button (47) in the mask images that Bernstein's software generates. These mask images overlie the control icons output by the standard browser interface. However, there is absolutely nothing in Bernstein which discloses or suggests that Bernstein's device dispenses any sheets to a user. Indeed a review of Figure 1 shows that there is absolutely no device whatsoever in Bernstein's

19

kiosk for printing a document. If a document could be printed, there is no way of delivering it to a user.

The Action asserts without support, that one of ordinary skill in the art would recognize that a sheet dispenser could be part of Bernstein's kiosk, and that when a user presses the print button the kiosk could print and dispense a sheet. This is mere hindsight from the teachings of Applicants' disclosure. Nothing in Bernstein discloses or suggests this. Such speculation is totally improper. As the Federal Circuit has held, an assertion in an Office Action that persons skilled in the art would recognize that a missing element may be included in a device cannot be based on probability or possibility. It is improper to reject a claim on the basis of anticipation because there is a possibility that a prior art structure "could" be used in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d, 1949 (Fed. Cir. 1999).

The "print" button Bernstein mentions may be used for numerous purposes that do not involve dispensing a sheet to a user. For example, the printing activity could occur remotely at another location away from the user, connected electronically to the kiosk. For example such a remote printed item may be produced in response to a user's indication that they wish to record their vote for or against a particular issue that the kiosk presents to them. Thus, the mere mention of the possibility that Bernstein's output may include a "print" button does not mean that a printed sheet is dispensed to a user.

As Bernstein contains no disclosure whatsoever that a sheet is dispensed, nor any equipment or capabilities which would enable dispensing a sheet to a user, as specifically recited in claim 1, it is respectfully submitted that Bernstein does not anticipate claim 1.

Claim 1 further patentably distinguishes over Bernstein in reciting that the claimed invention is operative to dispense a sheet from the banking machine in response to receiving an

20

HTML format document including a dispense instruction therein. Nothing in Bernstein discloses or suggests this.

As previously discussed, Bernstein causes mask images to be generated which overlie portions of the standard browser interface. The user actuatable "button" images which Bernstein may include in his overlying mask images correspond only to the standard browser functions which the browser can perform (Col. 5, lines 34-35; Col. 5, line 66 - Col. 6, line 5). As a result, the device of Bernstein merely provides another way for a user to select and actuate standard browser functions which the owner of the kiosk allows the user to actuate.

Nothing in the disclosure of Bernstein enables a sheet to be dispensed in response to instructions included in an HTML document as specifically recited in claim 1. Although Applicants respectfully contend that the device of Bernstein cannot dispense any sheets to a user, if Bernstein were to be modified to provide such capability as asserted in the Action, it would still not cause sheets to be dispensed in response to instructions in HTML documents. Rather, as shown in Figure 4, a user wishing to print a document would have to "touch" the "print" button (47) to cause any kind of printing activity. Thus Bernstein discloses initiating this function only in response to a manual input.

In contrast, claim 1 specifically recites that Applicants' automated banking machine is operative in response to receiving an HTML format document including a dispense instruction, to cause the sheet dispenser mechanism to dispense at least one sheet. Nothing in Bernstein discloses or suggests dispensing sheets, let alone controlling dispensing in response to instructions included in HTML documents. It is respectfully submitted that claim 1 is further allowable on this basis.

Claim 1 further recites that in Applicants' exemplary embodiment the software running in

21

the computer includes an HTML document handling portion which receives HTML format documents, and a device application portion which interfaces with the HTML document handling portion and the sheet dispenser. Claim 1 specifically recites that the device application portion is operative to cause a sheet to be dispensed from the sheet dispenser mechanism in response to the HTML document handling portion of the software receiving an HTML format document including a dispense instruction.

The software architecture of Bernstein is nothing like that recited in claim 1. While Bernstein includes a browser which may receive HTML documents, Bernstein does not have a sheet dispenser, let alone a device application software portion which operates to interface with and control a sheet dispenser.

The Action points to nothing in Bernstein which corresponds to Applicants' device application software portion. Rather it appears that in the Action such portion is somehow asserted to be "inherent". Such an assertion is plainly improper as there is no showing in the Action by citation to prior art that the claimed feature is necessarily present in Bernstein. *In re Robertson (supra).*

Bernstein does not have a software portion which corresponds to Applicants' device application portion and which controls a sheet dispenser (or any other device) in response to instructions passed through the browser to the device application portion. Bernstein's software architecture involves proprietary GUI control software and a mouse driver which provides a front end for the browser. As a result when a user "touches" a button corresponding to an icon in one of Bernstein's overlying mask images, the instruction is passed from Bernstein's GUI control software to the browser, which then performs the corresponding standard browser function (Col. 5, lines 29-45). As a result Bernstein makes amply clear that his GUI control software passes an

22

instruction to the browser which then performs the function in the usual way (Col. 6, lines 1-9).
Nothing in Bernstein discloses or suggests a software architecture which includes an HTML
document handling portion and a separate device application software portion, and in which the
device application portion operates the devices in response to instructions which are passed from
the browser.

Because Bernstein does not include numerous features and relationships which are
specifically recited in claim 1, it is respectfully submitted that claim 1 as well as all the claims
that depend therefrom, patentably distinguish over the cited art and should be allowed.


### The Action Does Not Apply Any Cited Art Against Claims 31-34

In the Action no cited art is applied against claims 31-34. In order to make a proper
rejection the Patent Office is required to specifically apply cited art to elements recited in the
pending claims. Instead of doing this the Action contains the following statement:

> "With respect to claims 31-34, the limitations of claims 31-34 are
>
> discussed in the rejection of claims and, therefore, will not be
>
> repeated".

It is respectfully submitted that this is not a basis for rejection. The statement provides
Applicants with absolutely no notice whatsoever concerning how these claims are allegedly
anticipated by features in the prior art. As the Action fails to indicate that any of the features
specifically recited in claims 31-34 are present in the prior art, it is respectfully submitted that
these claims should be allowed.

## Claims 31-34 Patentably Distinguish Over the Bernstein Reference

The features and relationships specifically recited in claims 31-34 patentably distinguish each of these claims over the Bernstein reference.

### Claim 31

Claim 31 recites an automated teller machine including a computer and browser software operating in the computer. Claim 31 further recites a sheet dispenser mechanism that is operated by the computer to dispense at least one sheet from the ATM in response to receipt of at least one HTML document by the browser.

As previously discussed, Bernstein does not disclose or suggest a sheet dispenser. Bernstein also does not disclose or suggest dispensing sheets in response to instructions included in documents received by a browser. As previously discussed, even the asserted interpretation of Bernstein in the Action (which Applicants have already pointed out is not correct) would only cause a sheet to be printed in response to a manual input. Nothing in Bernstein discloses or suggests dispensing sheets such as currency notes in response to instructions included in HTML documents.

As claim 31 specifically recites these features and relationships which are not disclosed or suggested in the Bernstein reference, it is respectfully submitted that claim 31 patentably distinguishes over the cited art.

### Claim 32

Claim 32 recites a method which includes operating a browser in at least one computer in connection with an automated banking machine. Claim 32 further recites receiving at least one

HTML format document with the browser, which document includes at least one dispense instruction. Claim 32 further recites the step of dispensing at least one sheet from a sheet dispenser in the banking machine responsive to receipt by the browser of the document including the dispense instruction.

As previously discussed in connection with claims 1 and 31, nothing in Bernstein discloses or suggests dispensing a sheet from a sheet dispenser. Further, nothing in Bernstein discloses or suggests dispensing a sheet in response to instructions included in an HTML document that is received by a browser.

As nothing in the cited art discloses or suggests these features, it is respectfully submitted that claim 32 as well as claim 33 which depends therefrom, patentably distinguish over the cited art.


## Claim34

Claim 34 is a method claim. Claim 34 includes the step of operating a browser in a computer in connection with an automated banking machine. Claim 34 further recites the step of receiving at least one document with the browser which document includes at least one dispense instruction embedded therein. Claim 34 further recites dispensing at least one sheet from a sheet dispenser in the banking machine, responsive to the browser receiving the document including the dispense instruction.

As previously discussed, nothing in Bernstein discloses or suggests a sheet dispenser or dispensing a sheet to a user. Further, nothing in Bernstein discloses or suggests dispensing a sheet such as a currency note, in response to instructions included in documents that are processed through a browser.

25

As Bernstein fails to disclose or suggest these numerous features which are specifically recited in claim 34, it is respectfully submitted that claim 34 patentably distinguishes over the cited art.

## Claims Which Depend From Claim 1 Further Patentably Distinguish Over the Cited Art

### Claim 10

Claim 10 depends from claim 1 and further recites that the banking machine includes a printer mechanism as well as a sheet dispenser mechanism. Claim 10 further recites that the printer mechanism is operated responsive to the device application software portion. Claim 10 further recites that the printer mechanism is operated in response to the device application software portion when a print instruction is received by the HTML document handling software portion.

As previously discussed, Bernstein does not disclose an automated banking machine with a sheet dispenser which dispenses notes and the like. Further, Bernstein does not disclose or suggest an automated banking machine which includes both a sheet dispenser and a printer mechanism. Indeed as previously discussed, Bernstein does not have a printer mechanism.

Bernstein also does not disclose or suggest a software architecture which includes an HTML document handling portion and a device application portion. Rather, Bernstein's system has a software front end to the browser which allows an owner of a kiosk to control the ways that a user can access standard browser functions. Further as previously discussed, nothing in Bernstein discloses or suggests a device application portion for controlling a printer in response to instructions which are passed from an HTML document handling portion.

26

The Action cites nothing in Bernstein which is asserted to correspond to these numerous features specifically recited in claim 10. It is therefore respectfully submitted that the Action does not present any valid basis for a rejection of claim 10.

As claim 10 recites these numerous features that are neither disclosed or suggested in the Bernstein reference, it is respectfully submitted that claim 10 is further allowable.

## Claim 11

Claim 11 depends from claim 1 and further recites that the banking machine includes at least one device. It is recited that the at least one device includes one of a printer mechanism, card reader mechanism, or a depository mechanism. Claim 11 further recites that the device operates responsive to the device application software portion. Claim 11 further recites that the device operates in response to receipt of a device instruction by the HTML document handling portion.

The Action contains no explanation of where the features that are specifically recited in claim 11 are asserted to be found in the prior art. For this reason it is respectfully submitted that no valid rejection to claim 11 is presented in the Action.

As claim 11 recites numerous features that are neither disclosed nor suggested in Bernstein, it is respectfully submitted that claim 11 further patentably distinguishes over the cited art.

## Claim 12

Claim 12 depends from claim 1 and further recites that the dispenser mechanism operates in response to dispensing sheets, to cause a dispenser operation message to be delivered to a

27

device application portion of the software. Claim 12 further recites that the HTML document handling portion of the software operates in response to delivery of the dispenser operation message to output a dispense response message from the HTML document handling portion. Nothing in Bernstein discloses or suggests these features.

As previously discussed, Bernstein does not disclose a dispenser mechanism. As previously discussed, Bernstein does not discuss a device application software portion that operates to cause sheets to be dispensed by a dispenser mechanism.

Further, nothing in Bernstein discloses or suggests a sheet dispenser mechanism causing a dispenser operation message to be delivered to a device application software portion. Likewise, nothing in Bernstein discloses or suggests an HTML document handling software portion operating in response to receipt of a dispenser operation message, to output a dispense response message from the HTML document handling portion.

The Action contains no assertion that the Bernstein reference includes any of these features. For this reason it is respectfully submitted that the Action fails to present a valid rejection of claim 12.

As claim 12 recites numerous features and relationships that are not disclosed or suggested in Bernstein, it is respectfully submitted that claim 12 is further allowable.


## Claim 13

Claim 13 depends from claim 11 and further recites that the device, which includes at least one of a printer mechanism, card reader mechanism, or depository mechanism, operates to cause a device operation message to be delivered to the application software portion. Claim 13 further recites that the HTML document handling portion operates in response to the device

application portion receiving the device operation message, to output a device response message from the HTML document handling portion. Nothing in Bernstein discloses or suggests this.

The Action fails to cite any features of Bernstein which correspond to these features specifically recited in claim 13. It is therefore respectfully submitted that the Action fails to present a valid rejection of claim 13.

As claim 13 recites numerous features and relationships that are not disclosed or suggested in the prior art, it is respectfully submitted that claim 13 is further allowable on this basis.

## Claim 14

Claim 14 depends from claim 12 and further recites that the HTML document which includes the dispense instruction and which causes the sheet dispenser to operate, also includes a response instruction. Claim 14 further recites that the response instruction causes the output of the dispense response message when the dispense operation message is delivered to the device application portion of the software. Nothing in Bernstein discloses or suggests anything like this.

The Action does not contain any assertion that the features specifically recited in claim 14 are discussed or suggested in the Bernstein reference. For this reason it is respectfully submitted that the Action fails to present a valid rejection of claim 14.

As claim 14 recites numerous features and relationships that are neither disclosed or suggested in Bernstein, it is respectfully submitted that claim 14 is further allowable.

### Applicants' Claims Are Not Obvious In View of The Cited Art

In the Action claims 4-5, 7-9, 15-20, and 25-30 were rejected pursuant to 35 U.S.C. §

29

103(a) as obvious over Bernstein. These rejections are respectfully traversed.

Applicants wish to point out that Bernstein is not prior art against Applicants. As later discussed herein, Applicants reduced their invention to practice in this country prior to the filing date of Bernstein.

Each of these additional rejected claims is rejected on the basis of "Official Notice". Applicants take exception to the assertion that features recited in Applicants's claims are known in the prior art. Applicants respectfully traverse this rejection. Applicants call upon the Patent Office to meet its burden of showing that such features are actually known in the prior art. MPEP § 2144.03. Applicants also wish to respectfully point out that this Patent Application has been effectively pending before the U.S. Patent Office for almost three and one half years and that any prior art cited must be documented as having an effective date in advance of Applicants' effective filing date and reduction of practice.

Applicants' respectfully submit that all of the rejections presented in the Action which are based on "Official Notice" are not properly supported and Applicants' traverse all such rejections.

## The Applicable Legal Standard

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish prima facie obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Even if all of the features of the invention are known in the prior art, an obviousness rejection is not proper unless the prior art teaches or suggests the desirability of making the

combination. MPEP § 2143.01. Absent of showing of a specific teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987), *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). Further, any teaching, suggestion, or motivation to combine features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the rejections in the Action on the basis of obviousness are legally improper and should be withdrawn.

## Applicants' Claims Patentably Distinguish Over the Cited Art

Applicants' pending claims recite numerous features and relationships that are not disclosed in the cited art.

## Claims 4, 5 and 17

In the Action claims 4, 5 and 17 were rejected based on alleged "Official Notice" of the following:

> "that either the web browser or the device application portion communicate
> or applets using TCP/IP through IP ports as claimed by the Applicant in the
> case. Due to the ubiquitous nature of the Internet, one of ordinary skill would
> realize that packets of information, or data, is sent though the Internet, or any

31

network, using TCP/IP. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have a web browser or device application portion transmitting messages through the Internet, or any network, since that is the standard to which information is sent. Only the obvious and expected result would have been obtained."

Applicants' respectfully take exception to the assertion that "Official Notice" can be taken of any prior art that would anticipate or render obvious the pending claims, as previously discussed. Applicants also respectfully take exception to this rejection as it fails to specify where features recited in the claims are known in the prior art, and further fails to cite any specific teaching, suggestion or motivation in the prior art so as to produce Applicants' claimed invention. It is respectfully submitted that the Action fails to state a legally sufficient basis for rejection of these claims, and Applicants' request that the rejection be withdrawn.

## Claim 4

Claim 4 depends from claim 1 and recites that in the banking machine of the claimed embodiment, the HTML document handling software portion and the device application software portion both communicate messages through TCP/IP. As previously discussed, nothing in the cited art discloses or suggests an automated banking machine with a software architecture that has both an HTML document handling portion and a device application software portion. As nothing in the cited art discloses such software architecture, clearly nothing in the cited art can disclose a banking machine with such software architecture and which communicates messages through TCP/IP.

Claim 4 further recites that the HTML document handling software portion communicates at a first IP port and that the device application portion communicates at a second IP port. As discussed in detail in the Specification, this aspect of the software architecture is useful in providing security features in the exemplary embodiment. Nothing in the cited art discloses or suggests an automated banking machine with a document handling software portion that receives messages that include instructions for operating a sheet dispenser at the first IP port, and which includes a device application software portion that operates to control the sheet dispenser communicating at a second IP port.

As nothing in the cited art discloses or suggests the features recited in claim 4, nor any teaching, suggestion or motivation to produce the elements and relationships cited in claim 4, it is respectfully submitted that claim 4, as well as claim 5 which depends therefrom, is allowable.

**Claim 5**

Claim 5 depends from claim 4 and further recites that the software operating in the computer in the automated banking machine further includes a device interfacing software portion. The device interfacing software portion interfaces with the sheet dispenser mechanism. Claim 5 further recites that the application software portion interfaces with the sheet dispenser mechanism through the device interfacing software portion. Claim 5 further recites that the device interfacing software portion communicates at a third IP port.

Nothing in the cited art discloses or suggests a software architecture as recited in claim 4 as previously discussed. Clearly nothing discloses or suggests such a software architecture plus a device interfacing software portion communicating at a third IP port. As discussed in detail in the Specification, the exemplary software architecture is useful in providing enhanced control

33

and security. Nothing in any of the cited art discloses or suggests the features specifically recited, nor is there any of teaching, suggestion or motivation to produce such an automated banking machine as specifically recited in the claim.

For these reasons, it is respectfully submitted that claim 5 is further allowable.

**Claim 17**

Claim 17 depends from claim 16, which in turn depends from claim 15, which depends from claim 1. It is respectfully submitted that claim 17 is allowable on the same basis as the claims from which it depends, claims 15 and 16 being discussed below.

Claim 17 further recites that an applet is operative to communicate through a second IP port and the device program is operative to communicate through a third IP port.

As previously discussed, nothing in any of the cited art discloses or suggests an automated banking machine with programs communicating messages through different IP ports. Further, nothing in any cited art discloses or suggests the recited software configuration with an applet communicating through a second IP port and a device program communicating through a third IP port. The Action fails to cite any teaching, suggestion or motivation in the prior art to produce the recited combination.

As the Action fails to provide any evidence that the recited features are known in the prior art and further fails to cite to supply any teaching, suggestion, or motivation in the prior art to produce the claimed combination, it is respectfully submitted that claim 17 is further allowable.

## Claims 7-9 and 15

In the Action claims 7-9 and 15 were rejected on the asserted basis of "Official Notice" that:

> "embedded instructions, JAVA and applets are notoriously well known
> 
> within the art.  There are many purposes of embedded instructions,
> 
> such as printing, assembly code and for pointers in databases.  Embedded
> 
> instructions allows a program to run faster and/or efficiently.  The
> 
> purpose of JAVA is that it is a write once, run anywhere type of language,
> 
> meaning that JAVA may be run on a variety of computer platforms and that
> 
> the computer does not have to store the program and applets are well known
> 
> to be written in JAVA among other languages.  Furthermore, JAVA is
> 
> notoriously well known to be used in Internet Browsers, such as Netscape
> 
> Navigator and Microsoft Internet Explorer.  Therefore it would have been
> 
> obvious to one with ordinary skill in the art at the time the invention was
> 
> made to incorporate embedded instructions or JAVA since embedded
> 
> instructions allows a program to run faster and/or more efficiently and
> 
> that JAVA can be run on a variety of platforms.  Only the obvious and
> 
> expected results would have been obtained.".

To the extent that this rejection can be understood, Applicants respectfully take exception.

Applicants respectfully assert that "Official Notice"cannot be taken that the claimed features

were known in the prior art.  There is no evidence that the features recited in Applicants' claims

35

were known in the art of automated banking machines at the time of Applicants' invention. Applicants further respectfully submit that the rejection is improper as it fails to apply any cited art to Applicants' claims in any meaningful manner.

Applicants further respectfully submit that the rejection of these claims is improper because it fails to cite to any teaching, suggestion or motivation in the prior art that would cause one having skill in the art to produce Applicants' claimed invention.

As this rejection presented in the Action fails to state a valid basis for rejection, it is respectfully submitted that it should be withdrawn and the claims allowed.


**Claim 7**

Claim 7 depends from claim 1 and further recites that the dispense instruction in the HTML format document which causes the sheet dispenser to dispense at least one sheet, is an embedded instruction.

As previously discussed, nothing in the prior art discloses or suggests an automated banking machine that is operative to dispense sheets in response to HTML documents or instructions therein. Clearly nothing in the cited art discloses or suggests an automated banking machine that causes a sheet to be dispensed in response to an embedded instruction in a document.

The Action has attached thereto a copy of a computer dictionary provided by Microsoft Press. Page 145 includes a definition of "embedded" which is an adjective referring to items such as program code or commands, that are built into their carriers rather than called when needed. The dictionary refers to an "embedded command" as a command placed in a document file by a program often as an instruction for producing a particular type of page layout or

36

character formatting on screen or when printed.

Nothing in this definition discloses or suggests using embedded commands or instructions for running devices such as a sheet dispenser in an automated banking machine. Indeed the cited dictionary reference shows that those having skill in the art have not previously conceived of a device and system as claimed by Applicants and further establishes the novelty of Applicants' claimed invention.

As nothing in the cited art discloses or suggests the features which are specifically claimed, nor do the cited references provide any teaching, suggestion or motivation so as to produce Applicants' invention, it is respectfully submitted that claim 7 is further allowable.

## Claim 8

Claim 8 depends from claim 1 and further recites that the dispense instruction included in the HTML document is JAVA script. Nothing in the cited art discloses or suggests automated banking machines which are enabled to dispense sheets in response to instructions in HTML documents. Nothing in the cited art discloses or suggests operating an automated banking machine in response to JAVA script instructions in HTML documents. There is no teaching, suggestion or motivation in any of the cited art so as to produce Applicants' claimed invention.

For all these reasons it is respectfully submitted that claim 8 is further allowable.

## Claim 9

Claim 9 depends from claim 1 and further recites that the device application software portion includes a first applet. Claim 9 further recites that the first applet is operative to cause operation of the sheet dispenser mechanism.

37

Nothing in the cited art discloses or suggests an automated banking machine that includes a software architecture with an HTML document handling software portion and a device application software portion. Further, nothing in any of the cited art discloses or suggests such a device application software portion that includes a first applet. Nothing in any of the cited art discloses such a software portion in which an applet is operative to cause operation of a sheet dispenser mechanism. As previously discussed there is absolutely nothing other than the disclosure in Applicants' Specification that would suggest such a software configuration or operating an automated banking machine in the recited manner.

As the Action fails to establish that the features recited in Applicants' claim are known in the prior art, and fails to cite any teaching, suggestion or motivation in the prior art to produce Applicants' claimed combination, it is respectfully submitted that claim 9 is further allowable.


## Claim 15

Claim 15 depends from claim 1 and further recites that the banking machine includes a plurality of devices. The devices are operative responsive to the device application software portion. Claim 15 further recites that the device application software portion include at least one applet that is operative to control at least one of the plurality of devices. Nothing in the cited art discloses or suggests this.

As previously discussed, nothing in the prior art discloses or suggests an automated banking machine with a software architecture that includes an HTML document handling software portion and a device application software portion. Nothing in the cited art discloses such a banking machine with a plurality of devices which are controlled by such a device application software portion. Further, nothing in the cited art discloses or suggests an applet

38

operative in such a device application software portion to control at least one of the plurality of devices. There is no citation in the Action to any teaching, suggestion, or motivation so as to produce Applicants' claimed invention.

As the cited art is completely devoid of the elements recited in claim 15, as well as any teaching, suggestion or motivation to combine elements so as to produce the claimed invention, it is respectfully submitted that claim 15 as well as claims 16-17 that depend therefrom are allowable.


## Claim 16

Claim 16 depends from claim 15 and it is respectfully submitted to be allowable on the same basis. Claim 16 further recites that the software operating in the computer of the banking machine further includes a device interfacing software portion that operates to interface with the plurality of devices. Claim 16 further recites that the device interfacing portion includes a device program operative to interface with an applet in the device application software portion.

In the Action it is acknowledged that Bernstein fails to teach or suggest anything about the use of applets. The Action asserts however that applets are notoriously well known in the art. As previously discussed, Applicants respectfully take exception to this assertion as the use of the claimed software architecture was totally unknown in the field of automated banking machines until the introduction of Applicants' invention. The Action further asserts in the rejection of claim 16, that the rejection of claims 7-9 includes citation to motivation in the prior art to produce the claimed invention. However the rejection of claim 7-9 includes no citation to any teaching, suggestion or motivation in the prior art to produce Applicants' claimed invention.

Claim 16 recites features and relationships which are not disclosed or suggested in any

39

cited art. It is therefore respectfully submitted that claim 16, as well as claim 17 which depends therefrom, are further allowable.

### Claims 18-20 and 25-29 Patentably Distinguish Over the Prior Art

In the Action claims 18-20 and 25-29 were rejected as "obvious" over Bernstein and Official Notice. Applicants' respectfully take exception as previously noted and particularly traverse the assertion that "Official Notice" can be taken of any prior art that is pertinent to Applicants' claims. Applicants respectfully submit that the Patent Office has not met its burden of establishing that the features recited in Applicants' claims were known in the prior art prior to Applicants' filing date on November 27, 1996 and Applicants' prior reduction practice. Applicants respectfully submit that the asertions in the Action have not been supported by citation to prior art as required by MPEP § 2144.03 and should therefore be withdrawn.

The Action asserts that it is well known for ATMs to connect to a network to determine if money is present in an account to dispense to a user. The Action acknowledges that Bernstein fails to teach a server relationship as claimed, whether in the form of a proxy server, home server or foreign server. The Action further acknowledges that Bernstein fails to teach a wide area network (WAN) as claimed. The Action further acknowledges that Bernstein fails to teach the use of screening software as claimed. The Action goes on to assert without support, that Official Notice" may be taken that one of ordinary skill would recognize that a kiosk used for web browsing would have servers since servers are an essential part of the Internet, or a WAN. The Action further asserts that screening software is used to prevent a machine from accessing a URL because corporations use screening software to prevent access to sites which are not authorized. It is alleged in the Action it would have been obvious to use servers, WANS and screening

40

software on an ATM that is connected since servers are well known to be connected to the Internet. Applicants respectfully disagree.

Nothing in the prior art discloses or suggests Applicants' claimed software architecture for an automated banking machine or system. Indeed the approach taken by Applicants was totally unknown prior to the development of such systems by Applicant. As the Action points out, even IBM has acknowledged the original development of this novel technology by Diebold, Incorporated, the Assignee of Applicants. (See U.K. Patent No. 2,328,532 page 1, lines 29-34, which is a U.K. patent application filed more than two years after Applicants' effective filing date of the present Application). Applicants respectfully submit that the Action contains no evidence that Applicants' recited elements were known in the prior art of automated banking machines prior to development of the present invention. Applicants further point out that the Action fails to establish that the prior art contains any teaching, suggestion, or motivation to produce Applicants' claimed invention. It is therefore respectfully asserted that this rejection should be withdrawn.

## Claim 18

Claim 18 depends from claim 1 and further recites a home HTTP server in operative connection with the HTML document handling software portion in the banking machine. Claim 18 further recites that the home HTTP server is operative to send the HTML documents which include the instructions for operating the sheet dispenser, to the HTML document handling software portion in the ATM.

Nothing in the cited art discloses or suggests an automated banking machine system which includes a home HTTP server which sends documents to an HTML document handling

41

software portion in a banking machine. Further, nothing in the cited art discloses or suggests such a system in which the home HTTP server sends documents which include instructions which are operative to cause the banking machine to dispense sheets such as currency.

As nothing in the cited art discloses or suggests these features it is respectfully submitted claim 18 further patentably distinguishes over the cited art.

## Claim 19

Claim 19 depends from claim 18 and further recites the home HTTP server specifically operates to send an HTML document including a dispense instruction to the banking machine. Again as previously discussed, nothing in the cited art discloses or suggests an automated banking machine system which such a software architecture, nor the use of HTML documents with dispense instructions that are operative to cause a banking machine to dispense sheets.

It is respectfully submitted that claim 19 is further allowable for this reason.

## Claim 20

Claim 20 depends from claim 18 and further recites that the home HTTP server includes a home address. Claim 20 further recites that the HTML document handling software portion in the banking machine is operative to send a message to the home address corresponding to the home HTTP server, in response to a user input at the input device of the automated banking machine. Nothing in the cited art discloses or suggests these features and relationships nor any teaching, suggestion or motivation to provide the claimed combination. .

For these reason it is respectfully submitted that claim 20 is further allowable.

42

## Claim 25

Claim 25 depends from claim 18 and further recites that the system includes a proxy server in operative connection with the home HTTP server. Claim 25 further recites that the home HTTP server has a home address, and that the HTML document handling portion in the banking machine has a machine address. Claim 25 further recites that the proxy server is operative to direct messages from the banking machine to the home HTTP server in response to the messages from the banking machine including the home address.

Nothing in the cited art discloses or suggests these features and relationships. Nothing in the cited art provides any teaching, suggestion or motivation to produce the claimed invention. For these reasons it is respectfully submitted that claim 25, as well as claims 26-28 that depend therefrom, are further allowable.

## Claim 26

Claim 26 depends from claim 25 and further recites that the proxy server is also in operative connection with a wide area network. It is further recited that the wide area network includes a foreign server and that the foreign server has a foreign address. Claim 26 further recites that the banking machine includes an address input device in operative connection with the HTML document handling software portion. Claim 26 further recites that the HTML document handling software portion is operative in response to input of indicia corresponding to the foreign address through the address input device, to generate a foreign message addressed to the foreign address of the foreign server. Claim 26 further recites that the proxy server operates responsive to receipt of the foreign address that pass the foreign message to the wide area network.

Nothing in the cited art discloses or suggests an automated banking machine system which has these features and relationships. Nothing in the cited art discloses or suggests an automated banking machine system that operates to perform in the manner recited. Nothing in the cited art discloses any teaching, suggestion or motivation to produce the claimed combination. For all these reasons it is respectfully submitted that claim 26, as well as claims 27 and 28 that depend therefrom, are further allowable.

**Claim 27**

Claim 27 depends from claim 26 and further recites that the proxy server includes screening software. Claim 27 further recites that the screening software operates to prevent the sending of the foreign message to at least one selected foreign address. Nothing in the cited art discloses or suggests the application of a proxy server with screening software to any automated banking machine system. Indeed nothing in the cited art discloses or suggests having an automated banking machine system that operates its transaction function devices in response to documents. Nothing in the cited art discloses or suggests an automated banking machine system that includes a wide area network with foreign servers to which messages may be directed by a proxy server. For all these reasons it is respectfully submitted that claim 27 is further allowable.

**Claim 28**

Claim 28 depends from claim 26. Claim 28 further recites that the proxy server operates in response to receiving a foreign response message from the foreign address directed to the machine address, to pass the message from the foreign server to the HTML document handling portion in the banking machine. As previously discussed, nothing in the cited art discloses or

44

suggests an automated banking machine system with a configuration as recited. Nothing in the prior art discloses or suggests a proxy server, a wide area network and foreign servers in connection with an automated banking machine and which operate to communicate messages in the manner recited.

As the cited art does not disclose or suggest the features recited in Applicants' claim, nor any teaching, suggestion or motivation to produce Applicants' claimed combination, it is respectfully submitted that claim 28 is further allowable.


## Claim 29

Claim 29 depends from claim 5 and is respectfully submitted to be allowable on the same basis. Claim 29 further recites that the apparatus includes a device server, and that the device application software portion and the device interfacing software portion communicate through the device server.

As previously discussed in connection with claim 5, claim 29 through incorporation of features in the base claims recites a software architecture in which an HTML document handling software portion communicates at a first IP port, a device application software portion communicates at a second IP port, and a device interfacing software portion communicates at a third IP port. Claim 29 further specifies that communication between the device application portion and the device interfacing software portion is through the device server. As discussed in the Specification this arrangement provides useful security aspects for the exemplary automated banking machine system.

Nothing in the cited art discloses or suggests the recited features in connection with an automated banking machine system. Further the cited art does not provide any teaching

suggestion or motivation to produce the claimed combination. Therefore it is respectfully submitted that claim 29 is further allowable.

## Claim 30

Claim 30 depends from claim 29 and is respectfully submitted to be allowable on the same basis. Claim 30 further recites that the device server includes monitor software, and that the monitor software operates to limit operation of the sheet dispensing mechanism.

It is asserted in the Action without support, that limiting the amount of sheets dispensed in the manner recited in the claims is known in the art. It is further asserted that it would be obvious to incorporate monitor software in case of a malfunction. Applicants respectfully disagree.

The Action fails to establish that a system configuration which includes a device server operating in connection with an automated banking machine, and which includes monitor software, is known in the cited art. The Action further fails to establish that monitor software operative in a device service to limit operation of a sheet dispensing mechanism in an automated banking machine, is known in the cited art. The Action further fails to point to any teaching, suggestion or motivation in the prior art to combine features to produce the claimed combination. For all these reasons it is respectfully submitted that claim 30 is further allowable.

## Applicants' Newly Submitted Claims Patentably Distinguish Over the Cited Art

Claims 35-47 have been added herein. These claims cite features and relationships recited in previously pending claims. These claims patentably distinguish over the cited art for the reasons previously discussed.

## Claim 35

Claim 35 recites an Automated Teller Machine which includes a computer and a browser operating in the computer. Claim 35 further recites that the ATM includes a card reader and a sheet dispenser mechanism in operative connection with the computer. Claim 35 further recites that the computer operates in response to reading indicia on a card with the card reader to cause the browser to receive at least one document, and that the computer is responsive to receipt of the document by the browser to enable the sheet dispenser to operate to dispense at least one sheet from the ATM. The features recited in claim 35 were previously presented in allowed claim 2 and claims 31-34.

The cited art does not disclose or suggest an ATM in which indicia read from a card input to a card reader is operative to cause documents to be received by the computer, which documents enable the dispense of sheets from the ATM. It is respectfully submitted that claim 35, like allowed claim 2, patentably distinguishes over the cited art on this basis. It is further respectfully submitted that claim 35 further patentably distinguishes over the cited art for the same reasons as claims 1 and 31-34. The arguments in support of the patentability of those claims is incorporated herein by reference as if fully written herein.

## Claim 36

Claim 36 is a method claim which generally corresponds to the apparatus recited in claim 35. Claim 36 specifically recites operating a browser in a computer in connection with an automated banking machine. Claim 36 further recites reading indicia on a card input by a user to a card reader in connection with a banking machine, and receiving at least one document with the browser responsive to the indicia read from the card. Claim 36 further recites that the document

47

received by the browser includes at least one dispense instruction. Claim 36 further recites enabling a sheet dispenser in connection with the banking machine, to dispense at least one sheet from the sheet dispenser responsive to receipt by the browser of the document which includes the dispense instruction.

As previously discussed, it was acknowledged in the Action that an automated banking machine which uses indicia read from a card to cause a document to be received by the machine, which document enables the banking machine to dispense sheets, clearly patentably distinguishes over the prior art. It is respectfully submitted that claim 36 is allowable on this basis. It is further respectfully submitted that claim 36 is further allowable for the same reasons as claims 1 and 31-34, and the arguments in support thereof are incorporated by reference as if fully rewritten herein.


**Claim 37**

Claim 37 is a claim generally similar to claim 34. Claim 37 however specifically recites that the sheet dispenser in the claimed embodiment dispenses currency notes. This type of sheet dispenser is specifically discussed as the type of sheet dispenser used in the exemplary embodiment (See page 9, lines 24-26 of the Specification). Nothing in the cited art discloses or suggests an automated banking machine that dispenses currency notes in response to HTML documents. While the Action asserts that the prior art discloses that a user of a kiosk may print a sheet showing an image that is displayed on a browser (an assertion which Applicants respectfully traverse), nothing discloses or suggests a system which operates to dispense currency in response to HTML documents. Further, nothing in any of the cited art discloses or suggests how features of the prior art could be modified so as to achieve the dispense of currency

48

in response to receipt of HTML documents by a browser or other document handling software operating in an automated banking machine. As nothing in the cited art discloses or suggest the claimed features, it is respectfully submitted that claim 37 is allowable.

**Claim 38**

Claim 38 is an apparatus claim directed to an ATM. Claim 38 is similar to claim 35, and the arguments in support of the allowability thereof are incorporated as if fully rewritten herein.

Claim 38 recites that the ATM includes a computer operating HTML document handling software. The ATM also includes a card reader and a sheet dispenser in operative connection with the computer. Claim 38 recites that the ATM operates responsive to reading indicia on a card, to cause the computer to receive at least one HTML document. The computer operates in response to the HTML document to enable dispensing sheets from the ATM.

As acknowledged in the Action with regard to allowed claim 2, Bernstein and any other prior art, does not disclose or suggest an ATM that receives HTML documents in response to indicia on a card input to a card reader of an ATM. Nothing in Bernstein discloses or suggests enabling the dispense of sheets from an ATM in response to receipt of HTML documents. As previously discussed, Bernstein does not disclose or suggest the dispense of sheets. Bernstein does not include the capability even if modified, to control any dispensing of sheets from an ATM in response to HTML documents. Bernstein can only perform the standard Netscape™ Browser functions. Even if Bernstein's kiosk were connected to a printer which provided documents to a user (which there is no cited teaching, suggestion or motivation to do), Bernstein would only produce a printed sheet in response to user input to this browser. Nothing in any document received by the browser in Bernstein would enable, control or cause the sheet to be

49

printed or dispensed to a user. Thus Bernstein even if modified based on hindsight from Applicants' teachings, does not provide the features and relationships as expressly recited in claim 38.

It is respectfully submitted that claim 38 is patentably distinguishable over the cited art and should be allowed.

## Claim 39

Claim 39 is a method claim. Claim 39 recites method steps carried out by an ATM apparatus of the type recited in claim 38. The arguments in support of claim 38 are incorporated by reference as if fully rewritten herein. It is respectfully submitted that claim 39 patentably distinguishes over the cited art and should be allowed.

## Claim 40

Claim 40 is an independent method claim that generally corresponds to claim 37. Claim 40 recites that the computer in the banking machine operates HTML document handling software rather than expressly referring to such software as a browser as in claim 37. The recitation of such software as HTML document handling software is found in the Specification and the original claims such as claim 1 and allowed claim 2. The recitation of this software as HTML document handling software also emphasizes that the invention encompasses the use of commercially available browsers as well as custom developed document handling software which produces visual and/or non-visual outputs.

It is respectfully submitted that claim 40 patentably distinguishes over the cited art and should be allowed.

## Claim 41

Claim 41 is an independent apparatus claim generally similar to claim 38. Claim 41 however specifically recites that the sheet dispenser in the automated banking machine is a note dispenser. Claim 41 recites that at least one note is dispensed from the banking machine in response to the document received by the banking machine, which document is received in response to the indicia read from a card read by a card reader. As discussed in connection with claim 38, the prior art does not disclose or suggest these features. The arguments in support of claim 38 are incorporated by reference as if fully rewritten herein.

It is respectfully submitted that claim 41 patentably distinguishes over the cited art and should be allowed.

## Claim 42

Claim 42 is a method claim which generally corresponds to claim 37. Claim 42 however further specifically recites that the sheet dispensed from the banking machine is a note. As previously discussed, nothing in the prior art discloses or suggests dispensing currency notes from a banking machine in response to receipt by the machine of HTML documents. The arguments in support of claim 36 are incorporated by reference as if fully rewritten herein.

It is respectfully submitted that claim 42 patentably distinguishes over the prior art and should be allowed.

## Claim 43

Claim 43 is an independent method claim that corresponds to independent apparatus claim 41. Claim 43 specifically recites that in the exemplary embodiment currency notes are

51

dispensed. The arguments in support of claim 41 are incorporated by reference as if fully rewritten herein.

It is respectfully submitted that claim 43 patentably distinguishes over the cited art and should be allowed.

## Claim 44

Claim 44 is an independent apparatus claim corresponding to method claim 42. Claim 44 however further specifies that the document(s) operatively causing the dispense of the notes is a mark up language document. (See Specification page 8, line 25). It is respectfully submitted that claim 44 patentably distinguishes over the cited art and should be allowed.

## Claim 45

Claim 45 depends from claim 44 and further recites that the banking machine includes a card reader. Claim 45 further recites that the computer is adapted to operate responsive to indica read by the card reader to cause the computer to receive the mark up language document(s) causing the at least one note to be dispensed. Claim 45 recites features acknowledged to be patentable in the Action in connection with claims 2 and 21 and is further allowable for this reason.

## Claims 46 and 47

Claim 46 is an independent method claim that corresponds to the apparatus recited in claim 44. Claim 47 depends from claim 46 and corresponds to apparatus claim 45. It is respectfully submitted that these claims are allowable for the same reasons as claims 44-45 and

the arguments in support thereof are incorporated by reference as if fully rewritten herein.

As each of new claims 35-47 recite features and relationships that are not shown or suggested in the prior art it is respectfully submitted that these claims should be allowed.

### Bernstein is not Prior Art Due to Applicants' Prior Deduction to Practice

Bernstein has an effective filing date of July 27, 1996. The pending Application has an effective filing date of November 27, 1996 based on the filing of Provisional Application 60/031,956. This Provisional Application supports all of Applicants' pending claims. Applicants are prepared to establish through submission of written documentation and sworn testimony that their invention was reduced to practice in this country prior to the filing date of Bernstein. However Applicants respectfully submit that Bernstein is so deficient in its teaching of elements and relationships which are specifically recited in the pending claims, and deficient in providing any teaching, suggestion or motivation so as to produce Applicants' claimed invention, that Applicants prefer to have their invention declared patentably distinct over Bernstein and all other cited art.

Applicants also respectfully submit that because their Application has been pending for such a long time that the citation of "Official Notice" in the Action is not sustainable. Applicants prefer to have the Patent Office make its very best efforts to search the relevant art, which Applicants believe will further prove that the features and relationships claimed by Applicants were not known in the art pertaining to automated banking machines at the time that the present invention was made. Applicants have traversed the rejections based on "Official Notice" and require the Patent Office to make a showing of the state of the relevant art at the time of the

53

invention as required by the Manual of Patent Examining Procedure. § 2144.03.

Applicants respectfully submit that the pending claims are all patentably distinguishable over the cited art, even though Bernstein is not appropriately classified as prior art against the invention of Applicants. It is therefore respectfully submitted that all the pending claims should be allowed.

## Additional Claim Fees

Please charge the fees for thirteen additional independent claims and thirteen additional total claims ($1248) and any other fee due, to Deposit Account 09-0428.
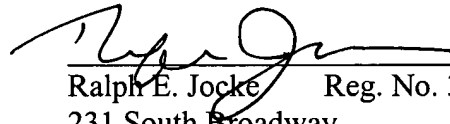
## Conclusion

Applicants respectfully submit that each of the pending claims recites features and relationships that are neither disclosed nor suggested in the cited art. For these reasons each of the pending claims should be allowed.

Applicants further represent that they are prepared to establish that the primary reference, Bernstein, does not constitute prior art against Applicants because Applicants reduced their invention to practice in this country prior to the filing date of the Bernstein reference. Applicants are not doing so at this time as the Action fails to present rejections establishing that the features recited in the claims are shown in Bernstein or in any other prior art pertinent to Applicants' invention which existed prior to the effective filing date of the pending Application.

Further examination and reconsideration of the claims is requested in view of the foregoing comments and amendments. The undersigned would be happy to discuss any aspects of the Application by telephone at the Examiner's convenience.

Respectfully submitted,

Ralph E. Jocke    Reg. No. 31,029
231 South Broadway
Medina, Ohio 44256
(330) 722-5143

FIG. 1

**FIG. 2**

FIG. 1

**FIG. 2**